

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROSS HANSEN

Appeal No. 97-1315
Application 08/264,976¹

ON BRIEF

Before CALVERT, ABRAMS and McQUADE, *Administrative Patent Judges*.

ABRAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the decision of the examiner finally rejecting claims 1-20, which

¹ Application for patent filed June 24, 1994. According to appellant, this application is a continuation of Application 07/616,613, filed November 21, 1990, now U.S. Patent No. 5,335,429, granted August 9, 1994.

constitute all of the claims of record in the application.

The appellant's invention is directed to an outer sole for wearing over footwear. The subject matter before us on appeal is illustrated by reference to claim 1, which reads as follows:

1. An outer sole for wearing over footwear having toe and heel portions, such outer sole being flexible and having toe and heel regions corresponding to the toe and heel portions of the footwear wherein the toe region of the outer sole is curled upwards in the absence of the footwear, to press preferentially against the toe portion of the lower surface of the footwear when the outer sole is attached thereto to resist the entry and accumulation of snow or dirt between the footwear and the outer sole.

THE REFERENCES

The references relied upon by the examiner to support the final rejection are:

Smith	3,019,533	Feb. 6, 1962
Beneteau	5,077,916	Jan. 7, 1992
Shimada (UK Patent Application)	2,140,273	Nov. 28, 1984

THE REJECTIONS

Claims 10, 12, 14 and 16-20 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point put and distinctly claim the subject matter which the appellant regards as the invention.²

² The portion of this rejection that was directed to claims 9, 11, 13 and 15 has been withdrawn in the Answer (page 2).

Claims 1 and 2 stand rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Shimada.

Claims 3-6, 9-14 and 17-19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Shimada in view of Beneteau.

Claims 7, 8, 15, 16 and 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Shimada in view of Beneteau and Smith.

The rejections are explained in the Examiner's Answer and in the final rejection (Paper No. 6).

The opposing viewpoints of the appellant are set forth in the Revised Brief.

OPINION

In reaching our decision on the issues raised in this appeal, we have carefully assessed the claims, the prior art applied against the claims, and the respective views of the examiner and the appellant as set forth in the Answer and the Revised Brief. Our conclusions follow.

The Rejection Under 35 U.S.C. § 112, Second Paragraph

There are two parts to this rejection. As we understand the first part, it is that indefiniteness exists because it is unclear whether the upward curl of 50-60 degrees in the outer sole, which is recited in claims 10, 12, 14 and 16-20, is present when the sole is free standing or when it is attached to the shoe. We agree with the appellant that one of ordinary skill in the art

would understand from the specification and the claims that the upward curl applies to the sole when it is in the free standing condition. It therefore is our view that indefiniteness does not exist on this basis.

The second part of this rejection pertains to claims 17-20, which the examiner asserts are duplicates of claims 10, 12, 14 and 16. We agree. While the appellant has acknowledged that errors in terminology appear in these claims and has suggested changes which in our view would cure the problem (Revised Brief, page 3), the fact is that instances of indefiniteness stand uncorrected by amendment, and therefore we have no choice but to sustain the Section 112 rejection of claims 17-20.

The Rejection Under 35 U.S.C. § 102(b)

It is the examiner's position that claims 1 and 2 are anticipated by Shimada. We have evaluated this rejection on the basis that anticipation is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of the claimed invention. See *In re Paulsen*, 30 F.3d 1475, 1480-1481, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994). Our conclusion is that the rejection cannot be sustained.

The essence of the appellant's invention is that the outer sole has an upward curl, in its free standing state, that is greater than that of the footwear over which it is to be worn, so that the toe (and heel) of the outer sole press against the corresponding portions of the footwear to create a tight fit. This provides resistance to the migration of snow or dirt in between the upper surface of the outer sole and

the lower surface of the footwear, thereby solving a problem that existed in the field prior art (specification, pages 2-4). This is manifested in independent claim 1 in the requirement that

the toe region of the outer sole is curled upwards in the absence of the footwear, to press preferentially against the toe portion of the lower surface of the footwear when the outer sole is attached thereto to resist the entry and accumulation of snow or dirt between the footwear and the outer sole.

Shimada is directed to an outer sole for covering the downwardly protruding spikes of a golf shoe, so that the wearer can walk across surfaces without imparting damage thereto. The problem to which the appellant has directed his inventive efforts is not acknowledged in Shimada. More importantly, however, Shimada does not explicitly disclose or teach, for whatever the reason, that there should be any difference in upward curvature between the outer sole and the footwear over which it is to be worn, much less that the upward curvature of the outer sole be greater than that of the footwear when it is free standing. Nor, in our view, would such a relationship in curvatures appear to one of ordinary skill in the art to be implicit from a review of the Shimada disclosure.

We therefore conclude that this requirement of claim 1 is not present in Shimada, and anticipation does not exist with regard to claim 1 or dependent claim 2.

The Rejections Under 35 U.S.C. § 103

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness (see *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993)), which is established when the teachings of the prior art itself would appear to have

suggested the claimed subject matter to one of ordinary skill in the art. (*See In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993)).

In the first rejection under Section 103, the examiner's position is that the subject matter in dependent claims 3-6, 9-14 and 17-19 would have been obvious in view of the combined teachings of Shimada and Beneteau. Shimada is relied upon for disclosing the subject matter recited in claim 1, from which all of these claims depend, and Beneteau for teaching that the gripping properties of the sole of a shoe can be improved by providing transverse ridges thereon. From our perspective, even considering Shimada in the light of Section 103, this rejection fails at the outset for the same reason as did the rejection of the independent claim, that is, Shimada's failure to disclose or teach the claimed upward curl of the outer sole in the free standing state. This deficiency is not cured by Beneteau, even assuming, *arguendo*, that it would have been obvious to combine the teachings of the two references.

This being the case, it is our view that the combined teachings of Shimada and Beneteau fail to establish a *prima facie* case of obviousness with regard to the subject matter of claims 3-6, 9-14 and 17-19, and we will not sustain this rejection.

We reach the same conclusion with regard to the Section 103 rejection of claims 7, 8, 15, 16 and 20, which is based upon the teachings of Shimada in view of Beneteau and Smith, the last being cited for its showing of self tapping screws being used in the sole of a shoe to improve traction. As was the case with Beneteau, the shortcoming in Shimada regarding the curvature of the outer sole is not

cured by Smith, and thus a *prima facie* case of obviousness is lacking in this rejection also, and it cannot be sustained.

SUMMARY

The rejection of claims 10, 12, 14 and 16 under 35 U.S.C. § 112, second paragraph, is not sustained.

The rejection of claims 17-20 under 35 U.S.C. § 112, second paragraph, is sustained.

The rejection of claims 1 and 2 under 35 U.S.C. § 102(b) as being clearly anticipated by Shimada is not sustained.

The rejection of claims 3-6, 9-14 and 17-19 under 35 U.S.C. § 103 as being unpatentable over Shimada in view of Beneteau is not sustained.

The rejection of claims 7, 8, 15, 16 and 20 35 U.S.C. § 103 as being unpatentable over Shimada in view of Beneteau and Smith is not sustained.

Appeal No. 97-1315
Application 08/264,976

The decision of the examiner is affirmed-in-part.

AFFIRMED-IN-PART

IAN A. CALVERT)
Administrative Patent Judge)
)
)
NEAL E. ABRAMS)
Administrative Patent Judge)
)
)
)
JOHN P. McQUADE)
Administrative Patent Judge)

BOARD OF PATENT
APPEALS AND
INTERFERENCES

NEA/dal

Appeal No. 97-1315
Application 08/264,976

DAVID J. FRENCH
P.O. BOX 2486, STN."D"
OTTAWA, CANADA, K1P 5W6